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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/015,868 | 12/12/2001 | Michael D. Hooven | HOOV 117 | 7290 |
| 26568 | 7590 | 03/11/2005 | EXAMINER | |
| COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606 | | | ROLLINS, ROSILAND STACIE | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 3739 |

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/015,868 | HOOVEN, MICHAEL D. | |
| | Examiner | Art Unit | |
| | Rosiland S Rollins | 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 December 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,4,6-10,12-14,17-20,22-24 and 27-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 3, 4, 6-10, 12-14, 17-20, 22-24, 27-49 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 10/12/8/20, 6/15
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 6-10, 12, 14, 17-20, 22, 24, 27-37, 39-44, 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Nezhat (US 6162220). Nezhat '220 disclose a device for clamping and ablating cardiac tissue comprising first and second handle members, first and second jaw members (figure 2E), first and second electrically conductive members (254, 258) having a width less than 1/3 the width of their associated mating surfaces and insulators.

Claims 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker (US 6113598). Baker discloses a tissue grasping apparatus comprising first and second grasping jaws, each jaw having an elongated electrically conductive member and at least one of the electrically conductive members define an interior lumen (figures 11-14c).

Claims 1, 13, 4, 23, 29, 31, 38 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi et al. (US 6273887). Yamauchi et al. disclose a tissue grasping apparatus that includes a wire as the conductive member as illustrated in Figures 74a & b.

Response to Arguments

Applicant's arguments filed December 8, 2004 have been fully considered but they are not persuasive.

Applicant argues that the Nezhat penetrates tissue by way of a cutting current applied to the electrodes. Applicant is attempting to establish current being conducted through tissue as meaning the same thing as penetrating the tissue. If this method is going to be used to define current being conducted through tissue then it must be used uniformly and also applied to Applicant's disclosure of current being conducted through the tissue to ablate the tissue. Given Applicant's definition of penetration, Applicant penetrates the tissue in the same manner as Nezhat.

Applicant also argues that Yamauchi includes incision projections, which are shaped to a point for penetrating tissue. Claim 1 recites that the jaw members must be adapted to contact cardiac tissue without penetrating such tissue along the clamping surfaces. In column 41 lines 26-27 Yamauchi meets this recitation by disclosing an example of when the jaw members can contact tissue without penetrating the tissue.

Applicant argues that the deformable jaw element of Baker is not an electrically conductive member. As Applicant pointed out, Baker discloses that a thin conducting film electrode may be placed over a surface of the deformable jaw element. It is the

Examiner's position that the thin film electrode located on the deformable jaw element establishes the deformable jaw element as a conductive member.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7 and 11 of U.S. Patent No. 6517536 in view of Nezhat. The patent 6517536 teach all of the limitations of the application claims except the conductive members having a width that is equal to or less than 1/3 of the width of the mating surface. Nezhat discloses a similar device that includes a conductive member having a width that is less than 1/3 of the width of the mating surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a conductive surface 1/3 the width of the mating surface on the patented device as taught by Nezhat since it has been established by Nezhat as a suitable dimension for treating heart tissue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.


Rosiland S Rollins
Primary Examiner
Art Unit 3739